



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

NISHIKAWA et al.

Atty. Ref.: 330-289; Confirmation No. 7024

Appl. No. 10/522,915

TC/A.U. 1794

Filed: May 18, 2005

Examiner: Blackwell

For: HIGH-DURABILITY PHOTOCATALYST FILM AND STRUCTURE HAVING
PHOTOCATALYTIC FUNCTIONS ON SURFACE

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October 17, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

This is responsive to the Official Action of April 21, 2008, a Final Rejection, and accompanies a Request for Continued Examination. Claims 1-7 and 9 remain pending in the application.

Claims 1, 2 and 9 are rejected under 35 USC §102(a) as allegedly being anticipated by WO 00/23523 otherwise identified in the Official Action and in this response as "WO '532". The corresponding U.S. patent is U.S. 6,737,145, reference to which will be made in the remarks that follow.

Before discussing the differences of the cited WO '532 reference and information countering rejection, it is important to bear in mind the legal requirements for establishing anticipation. To anticipate a claim, a single prior art reference must disclose each and every element of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F. 3d 1473, 1477, 33 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997), citing *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995); *Verdegall Bros., Inc. v. Union Oil Co.*, 814 F.2d 1000, 1000 (9th Cir. 1987).